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Supreme Court of the United States.

OCTOBER TERM, 1952.

RUSSELL BOX COMPANY,
Petitioner,
v.
GRANT PAPER BOX COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Russell Box Company, respectfully prays that a writ of certiorari issue to the Court of Appeals for the First Circuit, to review the judgment of that Court entered on March 31, 1953, affirming the final judgment of the District Court for the District of Massachusetts entered on July 17, 1952, and the judgment of said Court of Appeals entered on April 17, 1946, reversing a previous interlocutory judgment of said District Court.

Brief History of the Case.

This action was brought by respondent, Grant Paper Box Company, for infringement of claim 3 of Dreymann patent 2,031,036, dated February 18, 1936. After the trial of the

case the District Court issued a memorandum of findings of fact and conclusions of law (61 U.S.P.Q. 209), and entered judgment for defendant, April 21, 1944, on the ground that claim 3 was not infringed.

On plaintiff's appeal the Court of Appeals differed with the conclusion of the District Court, but on November 7, 1945, affirmed the judgment on the ground that claim 3 was invalid for lack of invention, in view of this Court's decision in *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327. See the opinion in *Grant Paper Box Co.* v. *Russell Box Co.*, 151 F. (2d) 886.

After rehearing, the Court of Appeals, on April 17, 1946, vacated its first judgment, held claim 3 of the patent valid and infringed, and reversed the judgment of the District Court. *Same* v. *Same*, 154 F. (2d) 729.

Defendant applied to this Court for writ of certiorari, but its petition was denied October 14, 1946. *Russell Box Co.* v. *Grant Paper Box Co.* (No. 297, October Term, 1946), 329 U.S. 741. The mandate of the Court of Appeals, remanding the case to the District Court for further proceedings, was thereupon issued, October 18, 1946.

On October 20, 1948, the District Court entered an interlocutory decree after mandate, vacating its judgment of April 21, 1944, adjudging claim 3 of the Dreymann patent valid and infringed, ordering an injunction, and referring the case to a Master for an accounting. On the same date the District Court denied a motion previously filed by defendant to limit the decree because Dreymann's original patent application, which was subsequently broadened by amendment without benefit of a supplemental oath, had disclaimed certain commercially available materials (thereafter used by defendant) as unsuitable for the purpose of his invention.

On July 17, 1952, after consideration of objections to the Master's Report, the District Court entered an order modi-

fying the report, increasing the damages awarded, multiplying the total damages and interest one and one-half times, and awarding substantial counsel fees. Final judgment was thereupon entered against defendant in an amount in excess of $200,000. The opinion of the District Court preceding said judgment is reported in 106 Fed. Supp. 616.

On defendant's appeal the final judgment of the District Court was affirmed, with an additional award of counsel fees to plaintiff. The opinion of the Court of Appeals, dated March 31, 1953, is reported in 203 F. (2d) 177.

The record on that appeal (C.A. 1, No. 4689, October Term, 1952), incorporates by reference the original record on the first appeal of this case (C.A. 1, No. 4044 October Term, 1944). Both records are submitted to this Court with the present petition. Petitioner will hereinafter use the notation "R-I" in referring to pages of the original record in Appeal No. 4044, and the notation "R-II" in referring to pages of the record of the accounting proceeding in appeal No. 4689.

Summary Statement of the Matter Involved.

The Dreymann patent in suit relates to a laminated paperboard used primarily in making boxes or cartons for packaging bakery products and other foods, and comprising two sheets of paper adhesively bonded together by a thin, moisture-vapor proof film composed of an amorphous petroleum wax carrying a suspended colloid. The patent describes the addition of specified non-petroleum colloids to a commercial petroleum wax, for satisfactory use as a laminating adhesive. The wax commercially used by plaintiff-respondent had a colloid content of approximately 25%. The adhesive film provided by this wax was flexible, to permit folding of the paperboard without cracking. Applied as a molten

liquid, the viscous wax did not penetrate the paper, and the surface of the board could be printed or written upon.

Laminated paperboards or boxboards, employing other moisture-proof waxes or adhesives as a bonding agent, were known and used long before Dreymann. His laminated sheet is an old combination of two layers of paper and an intervening adhesive film which bonds the layers and which is substantially impermeable to moisture or water vapor.

Amorphous petroleum wax, also known as "microcrystalline wax" or "petrolatum wax," is derived from petrolatum, an unrefined end product of petroleum distillation, by removing oil therefrom. The viscous wax has an apparent melting point varying between 120° F. and 170° F., and usually contains resinous colloids as impurities. The colloidal content of different grades or types of commercial amorphous petroleum waxes may vary between 5% and 35%, according to the composition of the crude oil from which it is derived, the refinery requirements, and the different methods employed for extracting oil from petrolatum.

Before Dreymann's discovery that the addition of colloids to certain grades of petroleum wax produced a satisfactory laminating agent for paperboard, amorphous petroleum wax was a commercially available material having known characteristics of viscosity, adhesiveness, flexibility and moisture-proofness, and the wax had been used commercially in moisture-resistant sizings or coatings for boxboard and other papers. Only trial and selection, as practised by defendant-petitioner with different grades of this wax, was necessary to demonstrate that a commercially available amorphous petroleum wax satisfactorily met the requirements of a laminating agent for paperboard to be used in making folding boxes. The requirement that a laminating material for folding boxes be a flexible, non-penetrating, moisture-proof adhesive was also known and appreciated before Dreymann's discovery.

Before producing the paperboard held to be an infringement herein, defendant-petitioner, in the years 1935-1936, tried three different grades of commercial amorphous wax, obtained from the refinery through its supplier, in paper laminating experiments. One of these waxes proved satisfactory, and defendant commenced commercial production in 1936. For several years defendant used an unblended wax, as it came from the refinery; but later, unwittingly, it used a blend of two different refinery waxes. The blended wax was found to contain approximately 25% of a resinous colloid native to petroleum. No foreign colloids were added at any time to the waxes used by defendant. Those waxes were applied by spreading the viscous, plastic material onto the paper with a doctor blade.

In Dreymann's patent the added foreign colloids are ester gum, aluminum stearate and cumarone resin. The addition of one or more of those non-wax colloidal substances was found necessary because the refinery wax which he used in his experiments did not have a sufficiently high colloidal content to satisfy his purposes.

Dreymann's original application for patent, filed May 17, 1934, acknowledged that amorphous waxes, as distinguished from crystalline paraffins, had been separated from petrolatum and oil and had been sold commercially; but he said that such petroleum waxes "are not adequate as intercalated films, uniting layers or plies of cardboard, for the layers can still easily be separated" (Exhibit K, R-I, p. 409, ll. 13-16). By this statement he disclaimed uncompounded commercial petroleum waxes from the purview of his invention, because they were unsuitable for the purposes of the invention.

Ten months later Dreymann's application was amended by changing the term "not adequate" to "not *always* adequate," and by cancelling the phrase "for the layers can still easily be separated." These changes were made without

filing the supplemental oath required when an amendment broadens the disclosure of a patent application, and without any statement explaining when these commercial waxes were sometimes adequate, or when they were not adequate.

Dreymann's claim 3 does not specify whether the "suspended colloid" is inherent in or added to the wax. It reads:

> "A container wall for the packaging of material including a sheet or film composed substantially of an amorphous petroleum wax of an apparent melting-point of 120°-170° F., carrying a suspended colloid, and two sheets of fibrous material, the sheet or film of said wax intercalated between the sheets of fibrous material and constituting a film of adhesive uniting the whole."

This claim was construed by the Court of Appeals to cover a boxboard laminated with a wax to which no colloid has been added. It thus describes an article consisting of a combination of elements which differ from previous combinations of boxboard elements only to the extent that a known amorphous petroleum wax containing a native colloid has been substituted for previously known adhesives as the laminating agent between two paper sheets.

Nevertheless, the Court of Appeals sustained the validity of claim 3, in the face of *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327, because the Court mistakenly believed that Dreymann was the first to discover the value of the known characteristics of amorphous petroleum wax for bonding paper to produce a laminated boxboard which was thin, flexible, foldable, moisture-vapor proof, and printable on the surface. The Court erroneously believed, moreover, that Dreymann's use of amorphous wax in place of other laminating adhesives resulted in a difference in kind, and in new function; and concluded that this case is gov-

erned by the distinction of *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 494, rather than by the doctrine of *Hotchkiss* v. *Greenwood*, 11 How. 248, that substitution of materials is not patentable.

Neither the premises nor the conclusions of the Court of Appeals for the First Circuit, respecting the scope and validity of claim 3 of the Dreymann patent, were acceptable to the District Court for the Western District of Pennsylvania, nor to the Court of Appeals for the Third Circuit, in *Sutherland Paper Co.* v. *Grant Paper Box Co.*, 82 Fed. Supp. 250, and 183 F. (2d) 926. In that declaratory judgment action Judge Gibson construed claim 3 as limited to the use of a wax to which a colloid foreign to petroleum had been added, and held the claim valid but not infringed by the use of an uncompounded amorphous petroleum wax. On the appeal Judge Hastie, for the Court, adopted the construction accorded to claim 3 by Judge Woodbury in the First Circuit, reversed the District Court, and remanded the case for further consideration of the validity of the claim in the light of that construction, and for the taking of additional evidence by Grant on the question of infringement. The case was not retried, and is understood to have been settled.

The merits of the Dreymann patent have been considered and decided on five occasions by four Courts, and no two of those decisions are in agreement with respect to both the scope and the validity of claim 3 None of these Courts have tested the validity of the claim as covering a non-inventive combination of old components, under the exacting standard of invention required by this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147.

Jurisdiction.

This is an action arising under the Patent Laws of the United States. Jurisdiction of such actions is conferred

upon the District Court by Title 28, U.S. Code, Sec. 1338 (a). The jurisdiction of this Court is invoked under Title 28, U.S. Code, Sec. 1254 (1); and is believed to be supported by *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra;* and by *Hamilton-Brown Shoe Co.* v. *Wolf Brothers & Co.*, 240 U.S. 251, 257, 258.

Questions Presented.

1. Does it constitute patentable invention to laminate paper by substituting a known and available amorphous petroleum wax, containing a native colloid and possessing known characteristics, for other laminating agents, to satisfy known or ascertainable requirements, in the manufacture of paperboard for folding boxes?

2. Does the trial or testing of a known and available material having known properties, as a substitute for other materials used in an old combination to produce an article for a particular use, involve invention, either (*a*) when the requirements for such use are known and the value of the properties of the substituted material for that use are also known, or (*b*) when the requirements for such use are first appreciated, and the value of such properties for such use are first discovered, by a patentee?

3. May an applicant for letters patent assert in his original application that a commercially available material is not adequate or satisfactory for the purposes of his invention; change the disclaiming statement and broaden his disclosure, without filing a supplemental oath, by asserting that that material is adequate for his purposes at some unspecified times; and then hold as an infringer of his patent a person using the commercially available material for such purposes?

4. When the validity, scope and infringement of a patent claim are at issue, should not all these questions be simulta-

neously decided by determining whether the acts of the *defendant* would have involved patentable invention if performed at the date of the patentee's alleged invention?

5. Is it permissible for a Court to award punitive damages and counsel fees when the acts subsequently adjudged to infringe were continued on advice of counsel in the honest belief that the patent was not infringed, and when four Courts, on five occasions, subsequently reached different conclusions respecting the scope and validity of the patent?

Reasons for Granting the Writ of Certiorari.

1. The public interest in the right to the free use of commercially available materials, in articles reaching the consumer in great volume, requires that any letters patent restricting such free use be carefully scrutinized in determining whether the patented improvement promotes the progress of science and the useful arts by adding to the sum of useful knowledge, or whether it retards progress by subtracting useful materials and resources from the field of research and experimentation by skillful men.

2. The public interest and the administration of justice in patent cases requires a review, and reconciliation or rejection, of the rulings of *Hotchkiss* v. *Greenwood, supra,* and *Smith* v. *Goodyear Dental Vulcanite Co., supra,* in the light of *Sinclair & Carroll Co., Inc.,* v. *Interchemical Corp., supra,* and more recent decisions of this Court imposing an exacting standard of invention in similar cases.

3. The conflicting interests of the public in the free use of available materials and resources, and of the inventor in the protection of his ingenious and imaginative efforts to promote the progress of science and industry, require a pronouncement by this Court as to whether the exacting standard of invention imposed in recent combination-of-elements cases also applies to substitution-of-material cases, with a

view of achieving uniformity of decision and avoiding the conflict of opinion exemplified by the inconsistent views of the four Courts which have considered the patent here in suit.

4. The judgment of the Court of Appeals for the First Circuit, if allowed to stand unchallenged, will promote controversy in patent cases and encourage solicitation and prosecution of many spurious patents of the character condemned in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* and will extend the scope of protection on minor improvements, in contravention of the constitutional standard of invention and the applicable decisions of this Court.

Wherefore, your petitioner respectfully prays that this petition be granted, and that a writ of certiorari issue to the Court of Appeals for the First Circuit, to review the judgments of that Court entered April 17, 1946, and March 31, 1953, herein, and that your petitioner may have such other and further relief in the premises as to this Court may seem meet and just.

RUSSELL BOX COMPANY, Petitioner,

By

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BRIEF IN SUPPORT OF PETITION.

Opinions of the Courts Below.

The memorandum of findings of fact and conclusions of law of the District Court, in support of the judgment of Judge Healey, entered April 21, 1944, herein, is not reported in the Federal Reporter. It appears in 61 U.S. Patents Quarterly, 209, and at R-I, pp. 14-18.

The first opinion of the Court of Appeals, rendered November 7, 1945, is reported in 151 F. (2d) 886; and the second opinion of that Court, rendered April 17, 1946, after rehearing, is reported in 154 F. (2d) 729.

The opinion of the District Court, in support of the final judgment of Judge Wyzanski, entered July 17, 1952, is reported in 106 Fed. Supp. 616, and appears at R-II, pp. 2-7.

The opinion of the Court of Appeals, affirming said judgment and dated March 31, 1953, is reported in 203 F. (2d) 177.

Jurisdiction.

The judgments of the Court of Appeals herein were rendered in a civil action arising under the Patent Laws of the United States. Jurisdiction of such actions is conferred upon the United States Courts by Title 28, U.S. Code, Sec. 1338 (a). The jurisdiction of this Court is invoked under Title 28, U.S. Code, Sec. 1254 (1).

Jurisdiction to reconsider and review the judgment of the Court of Appeals entered April 17, 1946, despite this Court's denial of a previous petition for certiorari to review that judgment, is supported by *Hamilton-Brown Shoe Co.* v. *Wolf Brothers & Co.*, 240 U.S. 251, 257-258.

Statement of the Case.

The essential facts supporting the grant of a writ of certiorari herein are believed to be sufficiently set forth in the summary statement of the petition.

Specification of Errors.

The Court of Appeals for the First Circuit erred—

1. In sustaining the validity of claim 3 of the Dreymann patent without limiting the claim to exclude from its scope the use of commercial amorphous petroleum wax containing a colloid native to petroleum.

2. In distinguishing this case from the case of *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327, on the erroneous findings that Dreymann was the first to discover the essential characteristics which a paper laminating agent should have to accomplish his purpose, and that he was the first to appreciate the value of those characteristics.

3. In distinguishing this case from the case of *Hotchkiss* v. *Greenwood*, 11 How. 248, on the erroneous findings that Dreymann's product differed from the prior art not merely in degree, but in kind, and that the use of his wax performed functions never performed before by bonding agents for paper.

4. In failing to adjudge that Dreymann's claim 3, when construed to cover defendant's product, was invalid for one or more of the following reasons:

(*a*) The claim merely describes a new use of a known and available material having known characteristics obviously satisfying the known requirements of paperboard for folding boxes;

(*b*) The claim merely describes the substitution, in an old combination, of a known and available material having known characteristics, for other materials hav-

ing similar characteristics, the suitability of the substitution being readily ascertainable by trial;

(*c*) The claim describes a combination of old elements performing no new function and achieving no unusual or surprising consequences by reason of the association of the old elements;

(*d*) The claim describes an article of manufacture capable of production by those skilled in and familiar with the prior art, without the exercise of the degree of inventive ingenuity required for patentability.

5. In adjudging that defendant infringed claim 3 of the patent.

6. In failing to adjudge that Dreymann's claim 3 was limited in scope, and hence not infringed by the use of a commercially available amorphous petroleum wax containing a colloid native to petroleum, on the ground that such limitation is required for one of the following reasons:

(*a*) In order to sustain the validity of the claim in view of the prior art and the adjudications of this Court in prior cases;

(*b*) Because the original application for patent disclaimed the adequacy and utility of such commercial wax for the purposes of the alleged invention, and was subsequently broadened by amendment to assert that such commercial wax was sometimes adequate and useful for those purposes, without benefit of a supplemental oath and without explaining when or in what circumstances the commercial wax was adequate.

7. In affirming the final judgment of the District Court awarding punitive damages and counsel fees to the plaintiff, and in awarding additional counsel fees to the plaintiff on the appeal.

Argument.

THE JUDGMENT OF THE COURT OF APPEALS DATED APRIL 17, 1946, IS ERRONEOUS AND IS IN CONFLICT WITH APPLICABLE DECISIONS OF THIS COURT.

A. The Court below applied a standard of invention less exacting than that required by Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147.

When claim 3 of the Dreymann patent in suit is construed, as it was by said judgment, to cover a paperboard comprising two sheets of paper laminated into boxboard by an adhesive film of available amorphous petroleum wax containing a native colloid, the claim protects a combination of old elements. That combination did not produce any new and unexpected result or achieve any surprising consequences. The improved result or function was due solely to the superiority of the selected wax, the properties of which were known and the effect of which was predictable.

Under this Court's considered judgment in the *A. & P.* case, such a combination is patentable "only when the whole in some way exceeds the sum of its parts," by performing a new and unexpected function or achieving unusual and surprising consequences, solely as a result of the new association and not attributable to the inherent and known properties of the old elements.

Whether the Dreymann patent is regarded as covering a combination of old elements, a substitution of one material for another, or a new use of an available substance, the standard of invention is the same in principle. See, for example, *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 91, holding that the principle of *Hotchkiss* v. *Greenwood, infra,* applies to a combination of old elements.

Whatever the approach, the fundamental question is whether the selection and utilization of a commercially avail-

able wax having known properties and capable of serving as a laminating agent for paperboard to be used in making a better folding box having improved characteristics due solely to those properties constitutes patentable invention.

By answering that question in the affirmative, the Court of Appeals departed from the high standard of invention imposed by this Court in conformity with the constitutional basis for patentability, and in the protection of the public interest in the free use of avaliable materials and devices.

B. The judgment of the Court below conflicts with the decision of this Court in Hotchkiss v. Greenwood, 11 How. 248.

Dreymann's claim 3, as construed by the Court of Appeals, covers a paperboard in which the available wax has been substituted for other laminating agents in an old combination. The *Hotchkiss* case is the precedent most frequently cited to the fundamental proposition that the substitution of one known material for another is not invention when the improved result is due solely to the superiority of the substituted material. In that case a door knob of clay or porcelain was substituted for knobs of metal or wood in an old combination in which the knob was attached to a shank and spindle.

The Court of Appeals concluded that the case at bar was governed by *Smith* v. *Goodyear Dental Vulcanite Co.,* 93 U.S. 486, rather than by the *Hotchkiss* rule, because it believed that Dreymann, like the patentee, Cummings, in the *Smith* case, achieved a difference in kind and used the wax to perform functions not previously performed by bonding agents. The Court acknowledged, however, that the difference in kind and function was due to the superiority of the wax, "a known compound having known characteristics" used "in combination with another known material" to

"produce an old article of manufacture" (154 F. (2d) 729, 731).

In the *Smith* case Dr. Cummings produced a superior denture plate by using hard rubber in place of metal, and vulcanizing the rubber to the artificial teeth so that the teeth were sealed tightly in the rubber plate. This Court distinguished the *Hotchkiss* case by emphasizing that Cummings' invention "is a product or manufacture made in a defined manner. It is not a product alone separated from the process by which it is created" (93 U.S. 493). Thus, in that case, the difference in kind and the new result were due, not only to the superiority of the substituted material, but primarily to the *new process* of vulcanizing the plate to the teeth. This Court's ruling that "We cannot resist the conviction that devising and forming such a manufacture *by such a process* and of such materials was invention" (93 U.S. 494; emphasis supplied), was not, therefore, in conflict with the distinguishable doctrine of *Hotchkiss* v. *Greenwood, supra.*

The case at bar is clearly governed by the *Hotchkiss* case, for Dreymann's claim 3 is for a product of manufacture, as such, and the claimed invention is completely independent of the process of manufacture. The Court of Appeals seriously erred in basing its decision upon the *Smith* case, and ignoring the true distinction upon which the patent in that case was sustained although the patent in the *Hotchkiss* case was invalidated.

C. The judgment of the Court below conflicts with the decision of this Court in Sinclair & Carroll Co., Inc., v. Interchemical Corp., 325 U.S. 327.

In its first opinion (151 F. (2d) 886) the Court of Appeals held that Dreymann's claim 3 was invalid in view of the *Sinclair* case, in which a patent for a commercially successful printing ink which achieved new functions was invali-

dated on the ground that the novelty resided in the selection and substitution of an available solvent for other solvents used in compounding ink. The new functions resulted from the superior and known properties of the substituted solvent which kept the ink from drying at room temperatures, but ensured instant drying under heat. The patentee, Gessler, discovered the utility of the solvent for his purposes by consulting a catalogue listing chemical solvents according to their rates of evaporation of different temperatures. This Court held that no invention was involved in thus selecting a known compound to meet known requirements.

In its second opinion after rehearing (154 F. (2d) 729) the Court of Appeals distinguished the *Sinclair* case on the ground that Dreymann not only found a laminating agent having characteristics which accomplished his purpose, but also discovered the characteristics which a laminant should have for such purposes, and first appreciated the value of the known properties of amorphous petroleum wax for his purposes. This distinction is unsound in law, and the premise is contradicted by the facts of this case.

Can it be seriously asserted that knowledge or appreciation of the requirements or characteristics needed to satisfy a particular purpose constitutes, of itself, an act of invention? No Court has so held, and such a mental deduction is manifestly non-inventive, for nothing has been accomplished. *Collar Co.* v. *Van Dusen*, 23 Wall. 530, 562.

When that act is followed by the non-inventive act of locating an agent known to have those characteristics, nothing has been added to nothing, and there can be no invention in taking the two non-inventive steps. The conclusion based on the Court's distinction was thus erroneous as a matter of law.

(If the first appreciator of the requirements produces a novel material or device having the desired characteristics, the act of deduction may well contribute to the inventive

quality of the result. Dreymann's synthesization of wax and non-wax colloids may have been an invention, on the findings of the Court of Appeals; but that question is beside the point of this discussion.)

But Dreymann was not, as the Court believed, the first to discover or appreciate that a moisture-proof, folding paper box for bakery products should be laminated with an adhesive film which is flexible to permit folding without cracking and loosing its moisture-vapor proof quality, and which does not penetrate the paper, so that the surface of the boxboard may be printed or written upon. Those characteristics and qualities are specifically set forth in the Fietsch patent of 1918 (Exhibit M, R-I, pp. 456-458), which describes a moisture-proof carton for cereals, crackers and other merchandise, made of paper laminated with a film of oxidized petroleum residuum. The patentee said that his petroleum laminant forms "a thin, pliant, waterproofing layer which firmly unites the layers of paper but does not penetrate the same to any appreciable extent"; and that the surface "may be printed upon and decorated in any desired manner."

The Court of Appeals obviously overlooked the Fietsch patent in finding as a fact that Dreymann discovered "the essential characteristics which a laminating agent for paper ought to have to accomplish the purpose he had in mind" (154 F. (2d) 730). In distinguishing this case from the *Sinclair* case, the Court committed an error of fact as well as of law.

By widely departing from the settled and salutory principles of the decisions of this Court, the Court of Appeals committed serious error, not only to the great cost and damage of the defendant-petitioner, but also to the detriment of the general public by so lowering the applicable standard of invention that solicitation and issuance of many patents for minor improvements involving the substitution of known

or newly developed materials are fostered and encouraged. The public will thus be obliged to forego its right to the free use of and experimentation with vast numbers of new plastics, alloys and other products which become commercially available every day; or to bear the trouble and expense of defending suits for infringement of many spurious patents of the type condemned in the *A. & P.* case, *supra.* The progress of science will be stifled, and conflict and confusion in the Courts will be magnified, if the judgment below is permitted to stand.

THE COURT OF APPEALS COMMITTED SERIOUS ERROR IN VALIDATING DREYMANN'S CLAIM 3 WITHOUT LIMITING ITS SCOPE, AND THEN HOLDING THE CLAIM INFRINGED BECAUSE IT READ BROADLY.

A. The Court below should have adjudged that the acts of the defendant could not infringe any valid claim of the patent in suit.

In this case, as in many patent infringement cases, the decision was reached by independently examining the issues of validity and infringement without adequate consideration of the effect of the prior art and applicable decisions in limiting the scope of the invention with respect to both issues. After holding claim 3 valid as it reads, on the basis of what Dreymann and the plaintiff and its licensees did, the Court below found that defendant infringed because the claim "reads broadly" and that a broad claim should not be restricted to the products or materials specifically recommended in the descriptive portion of a patent, especially when defendant's material was found to be a functional equivalent of that described.

Such analysis ignores the vital and fundamental question presented when the issues of validity, scope and infringement are in serious dispute, namely: *Would the acts per-*

formed by the defendant have involved a patentable invention, if performed at the date of the patentee's alleged invention?

That question can invariably be answered on facts rather than on theories, without consideration of abstruse and obscure patent specifications, claims and file wrappers; for what the patentee said or did is unimportant. The answer can be reached directly, understandably and quickly, by a consideration of the defendant's acts, the effective prior art and the applicable decisions.

If the answer is "No," the case is ended, for the defendant does not infringe any *valid* claim of the patent in suit. If the answer is "Yes," then it becomes necessary to examine the patent to answer the resulting question: Do the claims of the patent cover the acts performed by the defendant? If so, the defendant infringes.

In the case at bar the principal question should obviously be answered in the negative; for it is apparent that defendant's acts in 1935 and 1936 would not have involved invention if performed at the time of Dreymann's discovery in 1933 or 1934, in view of the acknowledged prior art and the decisions discussed above. On the finding of the Court of Appeals, in its first opinion (151 F. (2d) 889):

> "The defendant, on the other hand, observing that petrolatum wax had certain characteristics which made it seem useful for laminating papers, *i. e.*, that it was flexible, highly moisture-vapor proof and adhesive when plastic, tried several commercial waxes until he found one that served the purpose, and this wax turned out to contain a resinous colloidal impurity native to petroleum in about the amount that the plaintiff somewhat earlier had found essential."

The Court below did not consider, on reason or authority, whether such observation and experimentation on the part

of the defendant would have amounted to invention in 1933; and committed manifest error in failing to do so, for a negative answer is inevitably forecast as a matter of law.

It is timely for this Court to simplify the conduct of patent cases, and substantially reduce confusion, conflict and erroneous conclusions in the lower Courts by endorsing this short, direct and frequently decisive approach and analysis of the ultimate issue—whether any valid claim of a patent is infringed.

B. The Court below erred in failing to limit claim 3 to exclude from its scope the use of commercial wax having no added colloid, such wax having been disclaimed in the original Dreymann application, and the disclaimer having been later qualified to broaden the disclosure, without benefit of a supplemental oath.

Dreymann's application as filed conceded that amorphous petroleum derivatives had been separated from petrolatum and sold as "wax" to distinguish them from crystalline "paraffin"; and he said that such petroleum waxes "are not adequate as intercalated films, uniting layers or plies of cardboard, for the layers can still easily be separated" (R-I, p. 409, ll. 14-16). By that statement he disclaimed and excluded uncompounded commercial petroleum waxes from the scope of his invention, because they were unsuitable for his purpose.

Months later his application was amended by changing the term "not adequate" to "not *always* adequate," and by cancelling the phrase "for the layers can still easily be separated" (R-I, p. 409, changes at lines 14 and 16). This amendment broadened the disclosed invention (supported by his original oath) by claiming that commercial waxes were sometimes suitable for the purposes of the invention. No supplemental oath was filed to support the broadening

amendment, and Dreymann did not explain when the commercial waxes were adequate, or when they were not.

Such attempts to broaden the scope of an invention by cancelling or qualifying a limiting disclaimer in the original application without the support of a supplemental oath have been universally condemned by the Courts; and the claims of patents granted after such broadening amendments have been held invalid or not infringed.

Mackay Radio & Telegraph Co. v. *Radio Corporation of America*, 306 U.S. 86, 100-101.
Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U.S. 47, 57-61.
Steward v. *American Lava Co.*, 215 U.S. 161, 168.

The settled rule in this respect is for the benefit of the public, which is entitled to rely upon the statement of invention as supported by the statutory oath of the applicant for the patent; for it is fundamental that no new matter may be added to the original application which governs the scope of the patent, and that whatever is affirmatively disclaimed is dedicated to the public unless qualification of the disclaimer is supported by the oath of the applicant.

The Court below failed to perform its duty to the public and to the defendant by refusing to adjudge that claim 3 was limited in scope by Dreymann's original disclaimer, and hence not infringed by defendant's use of a commercial, uncompounded petroleum wax.

Conclusion.

The erroneous conclusions of the Court of Appeals for the First Circuit, in its judgment rendered April 17, 1946, materially affect the rights of the public as well as the rights of litigants in patent cases, by establishing, as a test of

the validity and infringement of patents relating to the substitution of materials, a standard lower than that required by the decisions of this Court in similar cases.

It is respectfully submitted that the petition for a writ of certiorari to review and correct that judgment should be granted.

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Supreme Court of the United States.

OCTOBER TERM, 1953.

No. 150.

RUSSELL BOX COMPANY,
Petitioner,
v.
GRANT PAPER BOX COMPANY,
Respondent.

BRIEF OF RESPONDENT OPPOSING PETITION FOR CERTIORARI.

The petition in this case presents no basis for *certiorari*. The single patent involved in this infringement suit expired in February, 1953, and is in the public domain, and with its expiration all rights of injunctive relief and all existing licenses thereunder expired. The defendant corporation (petitioner) has not operated its business since December 31, 1943, long before the injunction pursuant to mandate issued. There are substantially concurring opinions in the Courts of Appeals for the First and Third Circuits as to the scope of claim 3 of the now expired patent.* No "special

*The Court of Appeals for the Third Circuit in a case on this same Dreymann patent agreed with the First Circuit as to the scope of claim 3 and as to filewrapper estoppel. As to validity, the Third Circuit considered that there was no adequate consideration of the prior art in the record and returned the case for further hearing by the District Court (*Sutherland Paper Co.* v. *Grant Paper Box Co.*, 183 F. 2d 926; cert. den. 340 U.S. 906). The case was subsequently settled.

and important reasons" exist for granting the writ (Rule 38(5)). The case does not fit in any category specified by Rule 38(5)(b). There is no conflict of decisions to be resolved and no claim is made that the Court of Appeals' decision is in conflict with applicable decisions of this Court. Nor is any matter of public importance involved.

No new or unique question of patent law is presented; the transferees* of the defendant-petitioner, in order to avoid payment of a money judgment, are the only ones now having any interest in the litigation and the public will gain no benefit nor suffer any loss from an adjudication one way or another by this Court. Except for the pocketbook of the petitioner, and its transferees, the questions raised are moot and academic. This Court is traditionally opposed to reviewing mere claims for money damages in ordinary controversies such as this in the absence of other persuasive circumstances (see Stern & Gressman, "Supreme Court Practice" (1950), p. 111).

Twice before in this lengthy litigation this same petitioner has unsuccessfully sought a writ of *certiorari:* 329 U.S. 741 (No. 297, October Term 1946), and 333 U.S. 874 (No. 653, October Term 1947). The first petition was particularly directed to the issues of validity and scope, the main issues of the present petition.

Brief History of the Case.

Suit charging patent infringement was filed by respondent against petitioner in February, 1941 (R-I, p. 1).† The

*The corporate defendant was liquidated and distributed its assets to the stockholders during the pendency of this litigation (*Russell Box Co.* v. *Grant Paper Box Co.*, 179 F. 2d 785, 786) and now continues its existence only for the purpose of this suit.

†In this brief we have adopted the practice of petitioner in referring to the original record as "R-I" and the accounting record as "R-II."

case was tried in December, 1943, and decided adversely to plaintiff, the Court finding non-infringement (R-I, pp. 13, 18). On appeal, the Court of Appeals for the First Circuit held the patent infringed, but on the basis of this Court's opinion in *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327, decided by this Court after submission of the case to the Court of Appeals, held the patent to be invalid (151 F. 2d 886). Pointing out that the parties had no opportunity to be heard on this *Sinclair* decision, and that the Court of Appeals had misconstrued it, rehearing was sought and granted, and the patent thereupon held valid and infringed (154 F. 2d 729). *Certiorari* to this Court was denied, 329 U.S. 741. The petitioner then initiated an unparalleled series of motions, appeals, and abatement proceedings, necessitating action not only in the courts below (R-II, pp. 186-198), but in the Massachusetts Supreme Judicial Court (R-II, pp. 176, 180-181). In addition, a declaratory judgment action (R-II, p. 183) against plaintiff's assignor, Dreymann, in the Western District of Pennsylvania was filed by this petitioner. The docket entries (R-II, pp. 186-198) since October 14, 1946, when this Court first refused *certiorari*, attest in some measure this unusual situation, as does the second, and now this third, petition to this Court.

Final judgment after accounting having been entered and the appeal dismissed, defendant now seeks in its present petition to again open all of the basic issues of invalidity, infringement, and alleged filewrapper irregularity, as to which it and the plaintiff for declaratory judgment in the Third Circuit case were equally unsuccessful.

The only new issue presented in the instant petition—that of increased damages and counsel fees (seventh specification of error, Pet. p. 13)—is not supported by petitioner's brief and is apparently abandoned. Evidently it was included only as a vehicle to make it appear to this Court that some new decision and some new question were involved,

whereas, in substance, this is a petition for rehearing of denial of the original 1946 petition without "intervening circumstances of substantial and controlling effect" (Rule 33(2)).

The Dreymann Invention.

If one were to accept the statements of the petition,* it would appear that Dreymann, the patentee, merely substituted "one wax for another" for its "known properties," contributed nothing to the sum of useful knowledge, and did something as obvious, uninventive and unimportant as substituting porcelain for wood in a doorknob. The salient facts are carefully avoided in the petition and the picture presented does not bear scrutiny. The facts are as follows, as shown by the record:

The Dreymann patent in suit (R-I, p. 359 *et seq.*) made available to the food and related industries, particularly to bakers, a package which, while it could be printed upon like ordinary cardboard or box-board and had all the appearance and flexibility of ordinary box-board, was fourteen times more moisture-vapor proof than asphalt board, the best product the art knew prior to Dreymann (R-I, pp. 33, 63).

Dreymann accomplished this remarkable and highly useful result where others failed. Wax as a moisture-vapor barrier between and uniting two sheets of paper had never been successful. The common waxes, such as paraffin, are crystalline (R-I, p. 184) and crack when folded (R-I, p. 360, col. 2, lines 26-27) and are not adhesive (R-I, pp. 107, 153). Dreymann used an amorphous or non-crystalline wax. The wax had to be melted to be spread as an even film. Ordinary

*Petitioner's statements are not supported by the record and petitioner nowhere makes any reference to the record. As later pointed out, some of these statements are plainly inaccurate.

hot wax in a thin layer would either soak into the paper like ink into a blotter (R-I, p. 165), or instantly chill like candle wax on cold marble, and afford no adhesion (R-I, p. 166), and, for a box, the layers of paper had to be firmly stuck together (151 F. 2d 886, 888-889). Dreymann discovered that, if amorphous petroleum wax, then a waste substance of the refining industry, carried a suspended colloid in effective amounts, under the required conditions it would neither soak into the paper nor chill to a hard material, but instead would immediately gel (R-I, pp. 176-178) into a thin, evenly spread, sticky non-cracking and flexible film that would remain tacky until another layer of paper could be pressed against and thereby adhesively secured to it (R-I, pp. 126, 127, 161, 162; 151 F. 2d 886, 888-889). Thus he solved the problem of providing an economical box-board that was pliable, attractive, odorless and capable of being printed upon and had a thin film barrier giving an astonishingly vaporproof quality, and the industry immediately accepted it (R-I, pp. 41, 42; 151 F. 2d 886, 890-891). Although this box-board sold for about twice the price of conventional box-board (R-I, p. 63), bakers from all over the United States called upon the Grant Paper Box Company, the respondent, for its new "Tredonia" boxes, paying not only the higher price, but freight charges far beyond the normal range (R-I, pp. 40, 42, 45).

Dreymann did not merely substitute a superior material for an inferior one, *he introduced a material having a critical and different behavior* to provide a film continuous enough to produce a moisture-vapor barrier, strong enough to prevent separation, which could be applied at high speed as a molten water-like liquid, but which gelled to a sticky layer upon contact with cold paper without soaking into the paper, and which did not crack when the box-board was folded. Public acceptance was immediate and Dreymann's

contribution to the sum of useful knowledge in the packaging art was substantial.

The Petitioner's Infringing Operation.

The petitioner in its infringing operation made a similar laminated product, but, instead of using a relatively pure form of amorphous petroleum wax (now more correctly called "micro-crystalline wax") and adding a colloid, first used a wax from one refinery (R-I, pp. 70, 301) so processed for this purpose as to be sufficiently rich in colloidal material or resins naturally occurring or "native" to petroleum or its by-products (R-I, pp. 155, 180-181, 190-191) as to supply a gel with delayed solidification, as described in the Dreymann patent. The wax (called "Benowax C") (R-I, p. 70) was of such unusual quality that petitioner contracted with the supplier for its exclusive use as a laminating material (R-I, pp. 99, 113). Later, when this refinery discontinued operations, the supplier duplicated it by carefully blending wax and colloid-bearing petrolatum (R-I, pp. 193, 303) to secure a colloid-containing mixture specially made to have the critical, desired characteristics which Dreymann taught to be essential (R-I, pp. 301, 306, 311, 312, 317, 318).

Although claim 3 defines the wax as "carrying a suspended colloid," petitioner asserted and still asserts (Pet. p. 21) non-infringement because it added nothing foreign to petroleum to the wax. The trial Court accepted this defense (R-I, p. 17), but it has been consistently rejected by the two Courts of Appeals which have considered the question (151 F. 2d 886, 890; 154 F. 2d 729, 731; 183 F. 2d 926, 929)—and for sound reasons. The Courts enforced well-established principles (as more recently applied by this Court in *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 339 U.S. 605).

Petitioner would have us believe that Russell's development was independent and that all it did was to buy a known wax available on the market having known qualities for use in making a moisture-vapor proof laminated product (Pet. pp. 4, 14, 15, 19-21). The record does not support this suggestion. Grant was well under way in commercial manufacture of the patented product in 1934 and 1935 (R-I, pp. 38-42) and placed a salesman in New England in January of 1936 (R-I, p. 43). Petitioner Russell had been working with paraffin and had tried other wax unsuccessfully in 1935 (R-I, pp. 224, 229, 230), and it was not until after the Dreymann patent issued in February, 1936, that Russell suddenly solved the problem of what wax would laminate successfully and commenced purchasing the specially prepared Benowax C (R-I, pp. 80-81, 99-100).

The earlier wax was from a single refinery, processed to have the desired properties; later a wax and a selected petrolatum were blended and this fact maintained as a trade secret by the supplier (R-I, pp. 99, 112-113, 301-311). Benowax C had the critical colloidal content (R-I, pp. 181, 186).* Finding of Fact No. 17 of the trial Court (R-I, p. 17) is undisputed and is to the fact that defendant's wax had a colloidal content of about 25%. That Benowax C had the critical gel-forming properties as taught by Dreymann and recognized by petitioner as essential is clear from the testi-

*Mr. Dreymann conducted a quantitative analysis of this wax and found it to contain about four or five times as much resinous material as the refined commercial wax used by Grant (R-I, p. 181). Dr. Brooks conducted a similar analysis (R-I, p. 186). The statement on page 3 of the petition that plaintiff-respondent's untreated commercial wax had a colloidal content of about 25% is an obvious error, as is the statement on page 5 that petitioner spread its wax on the paper with a doctor blade (see R-I, pp. 226-227, 403). Petitioner used a different laminating machine, but nevertheless one requiring these special characteristics of gel formation and delayed solidification (R-I, p. 353).

mony of petitioner's expert, Sidebotham, who built defendant's laminating machine (R-I, pp. 226, 353).

Sinclair Case Inapplicable.

Petitioner particularly relies (Pet. pp. 16-19) upon the *Sinclair* case (*Sinclair & Carroll Co., Inc.*, v. *Interchemical Corp.*, 325 U.S. 327), stating that the Fietsch patent (R-I, p. 457) played the same role with respect to Dreymann's contribution as did Hanson's article with respect to Gessler in the *Sinclair* case (see 325 U.S. 327, 333). It will be remembered that Hanson had taught that to make a quick-drying ink what was needed was a solvent having negligible vapor pressure. With Hanson's teachings, Gessler had only to consult a catalog containing a list of known solvents with their vapor pressures to select the right one to make his ink. Fietsch, on the other hand, taught the art only that it was possible to laminate with air-blown asphalt (*i.e.*, oxidized petroleum residuum). Asphalt board was only one-fourteenth as moistureproof as Dreymann's product (R-I, p. 63). Fietsch said nothing about laminating with wax, let alone amorphous wax. In short, there is no teaching in Fietsch which would have enabled Dreymann to go to any existing tabulation of known materials and select the right one for his purpose. Fietsch only taught that you should laminate with something *not a wax*. The Court of Appeals for the First Circuit properly rejected the *Sinclair* decision as irrelevant (154 F. 2d 729, 730). For similar reasons petitioner's reliance upon *Hotchkiss* v. *Greenwood*, 11 How. 248 (Pet. pp. 15-16) rests upon facts not shown to exist by the record but as petitioner would like them to exist. Dreymann discovered the remarkable moisture-vapor resistance of amorphous wax in this environment and the way to put it to use.

A. & P. Case Likewise Inapplicable.

Petitioner also relies (Pet. p. 14) upon the *A. & P.* case (*Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147). It states that the patented container wall was a mere combination of old elements, each serving its expected purpose. Dreymann's laminated wall contained an unbroken barrier of amorphous wax with a colloid to give it the critical properties recognized by no others as necessary, which wax had never been placed in this setting before and which performed a new and surprising function, whereas the *A. & P.* case involved an aggregation of well-known mechanical elements, each of which acted as it had before, performing no new or unexpected function.

The Petitioner's Specification of Errors.

Pages 12 and 13 of the petitioner's brief lists seven specific errors and, except for the seventh, concerning which there is no supporting argument, all involve questions previously raised in the earlier petitions to this Court and which turn fundamentally on questions of fact rather than law, together with a filewrapper question as to which the Courts of Appeals of the First and Third Circuits were in accord. They may be reduced to three questions:

(1) Did the defendant infringe by using a special wax having the colloid properties built into it from refining and blending rather than using refined amorphous wax and adding a colloid, the claim covering the product, not the process?

(2) Is the patent valid in the light of the prior art?

(3) Did the Commissioner of Patents in his administrative capacity err in granting the patent without the formality of a supplemental oath after an inconsequential change was made in the specification—a point not

raised in the original trial, the matter having been *raised for the first time after the mandate of the Court of Appeals?**

The first question therefore turns on a review of the facts. The Courts of Appeals for both the First and Third Circuits are in agreement that it is the presence of the colloid, not its source, that is material (footnote, *supra*, p. 1). Hence the only issue is factual, whether the evidence supports the finding that the required colloid is present, and was resolved against petitioner and is now undisputed (Pet. p. 5).

The second question likewise is one that hinges on the evidence and one as to which there is no conflict between two or more Circuits. The question is whether the prior art discloses or suggests the invention and whether the correct standard of invention was applied. This Court is therefore now asked to review numerous prior art patents and measure their disclosures against the Dreymann patent in the absence of any compelling reason why it should do so in a case which can now affect only these litigants and which consequently is of no public importance.

There is no evidence that any prior art patent disclosed the use of an amorphous wax with this important gel-forming characteristic as a membrane both separating and uniting two sheets of paper, and no evidence showing that anything but that one material is satisfactory. There is nothing to suggest its use. To say more is to argue the merits of the case, and it is significant that two Courts of Appeals as well as the Patent Office have refused to accept the most relevant prior art as anticipating the invention.

The third question, having been raised as an afterthought in this case after mandate and after it was first raised in the

*Petitioner filed a motion to recall the mandate; subsequently it filed a motion to limit the decree and appealed from the adverse ruling (R-II, p. 205).

Third Circuit, disqualifies it as a matter for consideration here. The Court of Appeals for the First Circuit, like the Third Circuit, rejected the filewrapper matter as an unimportant issue. As Judge Hastie said (183 F. 2d 926, 932): "The difficulty with plaintiff's [the infringer's] second objection, that changes were made in the application without a concurrent filing of a supplemental oath, is that plaintiff has failed to establish the importance of these changes." With this view the First Circuit Court of Appeals was "entirely satisfied" (203 F. 2d 177, 180).

The decisions of both Courts of Appeals are supported by the decisions in other Circuits involving like amendments to patent specifications, as in *Michigan Carton Co.* v. *Sutherland Paper Co.* (C.C.A. 6), 29 F. 2d 179, 184, and *Procter & Gamble Manufacturing Co.* v. *Refining, Inc.* (C.C.A. 4), 135 F. 2d 900, 903-905. The question of the amendment to the specification, being an afterthought after full trial on the merits and after mandate, is no issue properly in this case, and the question, moreover, is one which has no merit and involves only facts peculiar to this one now expired patent and of no general public concern.

The Seventh Specification of Error.

The seventh specification of error is not discussed in the petitioner's brief and presumably is not relied upon. It has to do with the discretionary act of the trial Court in increasing damages and awarding attorneys' fees under the applicable statute (35 U.S.C. (1946) Sec. 70). The exercise of discretion by the District Court is not shown to be contrary to sound judicial practice, and its action was reviewed and found "wholly justified" by the Court of Appeals (203 F. 2d 177, 183). Indeed, that Court allowed additional attorneys' fees (203 F. 2d 177, 184). No abuse of discretion is

claimed or shown. No reason being presented why that discretionary award of increased damages and attorneys' fees should be reviewed by this Court, *certiorari* should be denied. The affidavit of William H. Parmelee (R-II, p. 176) clearly shows gross abuse of judicial process and misconduct, providing sound reasons for the discretion exercised by the trial Court and approved by the Court of Appeals.

Conclusion.

The patent in suit having expired, there is no question of public importance involved at all, no unique principle or problem of patent law is presented, and the petition deals only with the disposition of ordinary situations in an ordinary way under ordinary proceedings in conventional patent cases. *Certiorari* should be denied.

Respectfully submitted,

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HAROLD B. WILLEY,

Supreme Court of the United States.

OCTOBER TERM, 1952.

No. 150.

RUSSELL BOX COMPANY,
Petitioner,

v.

GRANT PAPER BOX COMPANY,
Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

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Supreme Court of the United States.

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GRANT PAPER BOX COMPANY,
Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Russell Box Company, respectfully prays that this Court grant rehearing of its order of October 12, 1953, denying the petition for writ of certiorari, and that, upon reconsideration, said petition be granted.

Brief Statement of the Case.

The petition, filed June 26, 1953, seeks a review of the judgment of the Court of Appeals for the First Circuit entered March 31, 1953, awarding to respondent damages and counsel fees in excess of $200,000, in an action for patent infringement. The petition also requests a review of

the previous judgment of that Court, entered April 17, 1946, holding the patent in suit to be valid and infringed; for this Court is authorized and "called upon to notice and rectify any error that may have occurred in the interlocutory proceedings." *Hamilton-Brown Shoe Co.* v. *Wolf Brothers & Co.*, 240 U.S. 251, 258.

The salient facts are concisely and correctly set forth in the petition, for they are found in the previous conflicting opinions of the Court below, and the petition challenges the conclusions of that Court on the facts relied upon in its opinions. Respondent's criticisms of the completeness and accuracy of petitioner's statement (Brief of Respondent, pp. 4 and 7), and its assertions respecting the special processing or quality of the wax used by defendant-petitioner (Brief, pp. 6 and 7), are unwarranted and misleading. In but one wholly unimportant respect petitioner was inadvertently inaccurate: on page 5 of its petition the word "spreading" should have read "scraping," in characterizing the application of respondent's wax by a doctor blade.

The fundamental question presented by the petition was essentially:

> Can a defendant be adjudged to infringe any valid claims of a patent which purports to monopolize the use, as a paper laminating agent, of a known and commercially available material employed as a substitute for other materials previously used as laminating agents, particularly when the patentee originally disclaimed the use of such material because it was unsatisfactory for his purposes?

The reasons why the Court of Appeals erred in answering that question in the affirmative, in contravention of the constitutional standard of invention and the applicable de-

cisions of this Court, are set forth in the brief in support of the petition.

Another question was raised by the petition but not argued in the brief in support thereof, namely:

> Is it permissible for a Court to award punitive damages and counsel fees to a plaintiff in a patent case when the acts eventually adjudged to infringe were performed on advice of counsel, and when four Courts, on five occasions, reached different conclusions respecting the scope and validity of the patent in suit?

Because the grounds in support of a negative answer to this question were not presented with the petition, respondent assumed (Brief, p. 3) that the point was not seriously raised and had been abandoned.

Reasons for Granting Rehearing and Issuing the Writ of Certiorari.

In addition to the grounds previously presented in support of its petition, petitioner submits that the Court of Appeals erred—

1. In affirming that part of the final judgment of the District Court which increased by 50% the damages computed by the District Court.
2. In affirming that part of the final judgment of the District Court awarding to plaintiff-respondent counsel fees in the sum of $30,000.
3. In awarding to plaintiff-respondent additional counsel fees of $2500 on the appeal.

The decision of the Court below is in conflict in principle with the decisions in other Courts of Appeals which observe the salutary rule that punitive damages are not allowable in a patent case unless the infringement was wanton and deliberate, and that infringement is not deliberate when the validity or infringement of the patent was open to honest doubt.

Metallic Rubber Tire Co. v. *Hartford Rubber Works Co.*, 275 Fed. 315, 326 (C.C.A. 2).
Rockwood v. *General Fire Extinguisher Co.*, 37 F. (2d) 62, 66 (C.C.A. 2).
Enterprise Mfg. Co. v. *Shakespeare Co.*, 141 F. (2d) 916, 920-921 (C.C.A. 6).
Goodrich Co. v. *Consolidated Tire Co.*, 251 Fed. 617, 624-625 (C.C.A. 7).

In this case, the questions of validity and infringement of the Dreymann patent were open to honest doubt until the Court of Appeals, reversing itself after rehearing, found the patent valid and infringed, in 1946, more than two years after defendant-petitioner had discontinued business. Subsequently, the Dreymann patent was held not infringed by Judge Gibson (*Sutherland Paper Company* v. *Grant Paper Box Company*, 82 F.S. 250, D.C. W.D. Pa.); and on appeal the Circuit Court of Appeals for the Third Circuit declined to follow the ruling of validity in the First Circuit, and remanded the case for a new trial (*Same* v. *Same*, 183 F. (2d) 926). That case was not retried. The Dreymann patent has been considered by four Courts on five occasions, and none of the five decisions are in agreement as to its validity and scope.

How, under such circumstances, can the assessment of punitive damages in the present case be reasonably justified, when the assessment was made primarily for the rea-

son that defendant-petitioner's infringement was said to be "due to carelessness in ascertaining the facts, carelessness in construing claim 3, or a combination of the two," and when it was conceded that petitioner was advised by its counsel and believed that it was not infringing?

Clearly, defendant's conduct does not demonstrate the wanton and deliberate infringement required by the aforesaid decisions in other circuits for the assessment of the punitive damages awarded in this case.

The award of counsel fees by the District Court was also affirmed because of defendant-petitioner's aforesaid carelessness, coupled with its failure to preserve its records and lack of co-operation during the accounting proceeding. The charge of "carelessness" being unsupportable under the circumstances related above, the penalty of $30,000 assessed on top of an unjustifiable increase of damages, for the explained loss of defendant-petitioner's records and for its lack of co-operation during the accounting proceeding, is clearly an abuse of discretion requiring redress.

The additional award of counsel fees by the Court of Appeals is a most unusual procedure; no reasons for such assessment are stated, and none are apparent in this case; and the approval of such an award as within the discretion of that Court will obviously tend to discourage losing parties who sincerely believe in the merits of their case from exercising their statutory right of appeal to that Court, contrary to the principles of justice.

Ever since the 1946 decision of the Court of Appeals, the defendant-petitioner has endeavoured without success to rectify an interlocutory judgment which is in conflict with the applicable decisions of this Court and contrary to the public interest in the free use of unpatented, commercially available materials used in place of less satisfactory materials previously employed for the same purpose. These efforts have been frustrated, and petitioner has been fur-

ther penalized by the unjustifiable awards to its adversary of large punitive damages and unconscionable counsel fees.

The interests of the public and of your petitioner can be secured only by reconsideration of the order denying the petition for certiorari, and the grant of that petition with respect to all questions presented therein.

Conclusion.

For the reasons set forth above and in the petition for writ of certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Appeals for the First Circuit to review and correct its judgments of April 17, 1946, and March 31, 1953, herein.

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I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay, and is restricted to grounds specified in Rule 33, par. 2, of the rules of this Court.

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Attorney for Petitioner.